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In re Application of	:	
Patrick Hung	:	DECISION ON PETITION UNDER
Application No. 09/625,442	:	37 C.F.R. 1.181 TO VACATE THE
Filed: July 26, 2000	:	EXAMINER'S REJECTION
For: CONFIGURABLE ELECTRONIC	:	
REDEEMABLE COUPON	:	

This is in response to applicant's Petition filed on May 24, 2004, requesting that several rejections in the Office action mailed March 18, 2004 be vacated.

1. The petitioner first requests that the Examiner should issue an affidavit in accordance with 37 CFR 1.104(d)(2) "in order to provide the Applicant an opportunity for response regarding whether the electronic coupon displayed in an alphanumeric format is a barcode format, since the examiner, in light of the lack of citation to authority, apparently asserts this interpretation based upon his personal knowledge." or alternatively to vacate the rejection of claim 8.

The Examiner has made several arguments to support his statements with regard to this issue, not the least of which is that Applicant acknowledges the existence of a plurality of well known barcode standards (UPC, UCC/EAN-128, CODE 49; specification at page 5). The Examiner has also stated that alphanumeric is a scanable format and makes an obviousness statement with motivation for modifying the primary reference of Mankovitz with any of these well known formats. The Examiner has in effect taken Official Notice and backed the statement up with Applicant's own statements of admittedly well known barcode formats. Applicant has had numerous opportunities to respond to both the statements made by the Examiner as well as their own admitted prior art statements concerning well known barcode formats. No affidavit is deemed to be necessary as at the very least Applicant has provided the prior art in their well known statements. The Examiner's rejection is correct and consistent with Office policy and practice. Accordingly, the Petition with regard to this issue is **DENIED**.

2. The petitioner next requests that the amendment after Final rejection filed January 20, 2004 should have been entered and the RCE filing was not necessary, and relatedly that the Examiner erred in rejecting claims 1-9, 11-13 and 16 in the first Office action after the RCE.

It is noted that the Examiner could have entered the After Final amendment, but it would not have changed the fact that the Application was under Final rejection. Applicants filing of an RCE was seen as necessary at this point in the prosecution in order to again bring the Application up for continued examination consideration. As the Final rejection issued August 25, 2003 was procedurally proper and as no affidavit was found to be necessary, the petition with regard to this request is **DENIED**. It is further noted that the first Office action after the entry of the RCE (mailed March 18, 2004) was not made Final, thus giving Applicant opportunity to respond to the changes in rejection that were made between the Final action mailed August 25, 2003 and the non-final action mailed March 18, 2004. It is additionally noted that the rejections issued in the March 18, 2004 Office action were indeed different in that Official Notice statements were specifically added to the reasoning in rejecting claims 1, 5, and 11.

3. The petitioner next requests that the Examiner vacate the rejection of claims 22 and 23 under 35 USC 102(b) and 103(a), respectively, based on the reference to Greenberg et al. (WO 00/39657).

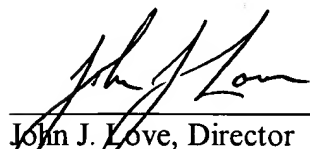
The petition is **DISMISSED** with respect to this issue as rejections are appealable, not petitionable. However, it is noted that the instant Application has a filing date of July 26, 2000, while Greenberg et al. has a publication date of July 6, 2000. Therefore Greenberg et al. is instead 35 USC 102(a) prior art, not 102(b). This typographical error does not change the fact that Greenberg et al. is valid prior art under 35 USC 102, and therefore valid under 35 USC 103.

4. The petitioner finally requests that the Examiner vacate the rejection of claim 23 under 35 USC 103(a) based on the reference to Cathey et al. (US 6,532,375).

The petition is **DISMISSED** with respect to this issue as rejections are appealable, not petitionable. However, it is noted that the instant Application has a filing date of July 26, 2000, while Cathey et al. has an effective filing date of April 24, 1998 due to it being a continuation of Application Serial No. 09/066,616 filed on that date. Since Cathey et al. qualifies as prior art under 35 USC 102(e), it is available as prior art under 35 USC 103(a).

If the petitioner desires further review of the Director's Decision, applicant should consider filing a Petition for Review of the Director's Decision under 37 CFR §1.181(a)(3).

Summary: *Petition Denied and Dismissed*



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